APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,231	05/04/2001	Barry Appelman	06975-130001	6250

26171	7590	05/05/2005

FISH & RICHARDSON P.C.
1425 K STREET, N.W.
11TH FLOOR
WASHINGTON, DC 20005-3500

EXAMINER
KE, PENG

ART UNIT	PAPER NUMBER
2174	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

✗✗

	Application No.	Applicant(s)
Office Action Summary	09/848,231	APPELMAN, BARRY
	Examiner	Art Unit
	Peng Ke	2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
 after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
 earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _30 June 2004_.

2a)☒ This action is **FINAL.**　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
　　closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-80_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-80_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _/10/04_
4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to communications: Amendment, filed on 6/30/04.

This action is final.

Claims 1-80 are pending in this application. Claims 1, 18, 22, 26, 57, 75, and 80

are independent claims. In the Amendment, filed on 6/30/04, claims 1, 18, and 23, and

26 were amended and claims 31-80 were added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 - 4, 6 - 9, 11 – 68, and 71-80 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Glenn et al., U.S. Patent Application Publication No. US

200210021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 further in view of

Schindler (US 6,081,830)

As per claim 1, Glenn et al. ("Glenn") teaches a communications method for

transferring electronic data between users of a communications system, the method

comprising: upon opening of the electronic message by the recipient, indicating an online

state of one or more of the sender and any other recipient of the electronic message (see

Glenn, paragraphs 0021 and 0022).

Glenn does not teach delivering an e-mail from a sender to at least one recipient and the electronic message as an e-mail message.

Kudoh et al. ("Kudoh") teaches delivering an e-mail message from a sender to at least one recipient and the electronic message as an e-mail message (see Kudoh, column 4, lines 32 - 36). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Kudoh with the method of Glenn in order to allow messages to be read hours or days after they are sent.

Glen and Kudoh teach the method of claim 1. (see rejection above). Glenn and Kudoh do not teach the method indicating one other recipient of the electronic message.

Schindler further teaches a method indicating the online state of the sender and every other recipient of the chat room. (See Schindler, column 7, lines 45-55)

It would have been obvious to an artisan at the time of the invention to include Schindler's teaching with method of Glenn and Kudoh in order to allow user to see the states of the other users.

As per claim 2, which is dependent on claim 1, Glenn, Kudoh, and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 further comprising sending a message to at least one of the sender and any other recipient based on the online state (see Glenn, paragraph 0046).

As per claim 3, which is dependent on claim 2, Glenn, Kudoh and Schindler teach the method of claim 2 (see rejection above). Glenn further teaches the method of claim 2 wherein the message comprises an instant message (see Glenn, paragraph 0046).

As per claim 4, which is dependent on claim 2, Glenn, Kudoh and Schindler teach the method of claim 2 (see rejection above). Glenn further teaches the method of claim 2 wherein the message comprises an e-mail message (see Glenn, paragraph 0046).

As per claim 6, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 wherein indicating the online state comprises displaying a graphical user interface to the recipient (see Glenn, figure 3, items 206 and 209 and paragraph 0022).

As per claim 7, which is dependent on claim 6, Glenn, Kudoh and Schindler teach the method of claim 6 (see rejection above). Glenn further teaches the method of claim 6 wherein the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message (see Glenn, figure 3, items 206 and 209)

As per claim 8, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above), Glenn further teaches wherein indicating the online state comprises indicating whether the sender is online, offline, or not a member of the communications system (see Glenn, paragraph 0022).

As per claim 9, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 wherein indicating the online state comprises accepting a request to check user online

state (see Glenn, paragraph 0045, lines 10 -15; it is inherent that the query to check user

online state is accepted because a result is returned).

As per claim 11, which is dependent on claim 9, Glenn, Kudoh and Schindler

teach the method of claim 9 (see rejection above). Glenn further teaches the method of

claim 9 wherein the request comprises an Internet protocol (see Glenn, paragraph 0025;

the examiner interprets the AOL instant messaging protocol as an internet protocol),

As per claim 12, which is dependent on claim 11, Glenn, Kudoh and Schindler

teach the method of claim 11 (see rejection above). Glenn discloses the method of claim

11 wherein the Internet protocol is hypertext transfer protocol (see Glenn, paragraph

0011).

As per claim 13, which is dependent on claim 9, Glenn, Kudoh and Schindler

teach the method of claim 9 (see rejection above). Glenn further teaches the method of

claim 9 wherein the request is initiated by a client of the user (see Glenn, paragraph 0045,

lines 10 - 15).

As per claim 14, which is dependent on claim 9, Glenn, Kudoh and Schindler

teach the method of claim 9 (see rejection above). Glenn further teaches the method of

claim 9 further comprising sending a redirection command based on the online state (see

Glenn, paragraph 0046; the examiner interprets sending the message via electronic mail

instead of as an instantaneous message when the user is offline as sending a redirection

command based on the online state).

As per claim 15, which is dependent on claim 9, Glenn, Kudoh and Schindler

teach the method of claim 9 (see rejection above). Glenn further teaches the method of

claim 14 wherein the redirection command comprises a uniform resource locator (see

Glenn, paragraph 0056, lines 17 - 24).

As per claim 16, which is dependent on claim 1, Glenn, Kudoh and Schindler

teach the method of claim 1 (see rejection above). Glenn further teaches wherein,

indicating the online state comprises establishing a persistent connection to an instant

messaging server (see Glenn, paragraph 0068).

As per claim 17, which is dependent on claim 1, Glenn, Kudoh and Schindler

teach the method of claim 1 (see rejection above). Glenn further teaches wherein

indicating the online state comprises checking a control port (see Glenn, paragraph 0127).

As per claim 18, it is of similar scope to claim 1 and is rejected under the same

rationale as claim 1 (see rejection above).

As per claim 19, which is dependent on claim 18, Glenn, Kudoh and Schindler

teach the method of claim 1 (see rejection above). Glenn further teaches the computer

program of claim 18 wherein the computer readable medium comprises a disc (see Glenn, paragraph 0150, lines 5 - 8).

As per claim 20, which is dependent on claim 18, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a client device (see Glenn, paragraph 0017).

As per claim 21, which is dependent on claim 18, Glenn, Kudoh and Schindler Kudoh teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a host device (see Glenn, paragraph 0153, lines 3 - 6).

As per claim 22, which is dependent on claim 18, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a propagated signal (see Glenn, paragraph 0152).

As per claim 23, it is of similar scope to claim 1 and is, rejected under the same rationale as claim 1 (see rejection above).

As per claim 24, it is of similar scope to claim 20 and is rejected under the same rationale as claim 20 (see rejection above).

As per claim 25, it is of similar scope to claim 21 and is rejected under the same rationale as claim 21 (see rejection above).

As per claim 26, it is of similar scope to claim 1 and is rejected under the same rationale as claim 1 (see rejection above).

As per claim 27, it is of similar scope to claim 6 and is rejected under the same rationale as claim 6 (see rejection above).

As per claim 28, which is dependent on claim 18, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 27 wherein a graphical user interface enabled for a first online state differs from a graphical user interface enabled for a second online state (see Glenn, paragraph 0022).

As per claim 29, it is of similar scope to claim 6 and is rejected under the same rationale as claim 6 (see rejection above).

As per claim 30, it is of similar scope to claim 28 and is rejected under the same rationale as claim 28 (see rejection above).

As per claim 31, which is dependent on claim 1, it is of the same scope as claim 8. (See rejection above)

As per claim 32, which is dependent on claim 1, it is of the same scope as claim 2.

(See rejection above)

As per claim 33, which is dependent on claim 1, it is of the same scope as claim 2.

(See rejection above)

As per claim 34, which is dependent on claim 1, Glen, Kudoh and Schindler teach

the method of claim 1. (see rejection above). Schindler further teaches a method

indicating the online state of the sender and every other recipient of the chat room. (See

Schindler, column 7, lines 45-55)

As per claim 35, which is dependent on claim 1, it is of the same scope as claim 8.

(See rejection above)

As per claim 36, which is dependent on claim 1, Glenn, Kudoh and Schindler

teach the method of claim 1, Glenn further teaches where indicating online state

comprises providing one or more indicator to the recipient. (Figure 2, item 206)

As per claim 37, which is dependent on claim 36, it is of the same scope as claim

34. (See rejection above)

As per claim 38, which is dependent on claim 36, it is of the same scope as claim

34. (See rejection above)

As per claim 39, which is dependent on claim 36, Glenn, Kudoh and Schindler

teach the method of claim 36, Glenn further teaches comprising selecting at least one of

the visual indicators to initiate at least one user interface. (Figure 2, item 206)

As per claim 40, which is dependent on claim 39, Glenn, Kudoh and Schindler

teach the method of claim 39, Kudoh further teaches wherein selecting the at least one

visual indicator initiates at least one user interface configured to enable the recipient to

send an email message communication to an identity associated with visual indicator.

(see Kudoh, column 4, lines 32 - 36)

As per claim 41, which is dependent on claim 39, Glenn, Kudoh and Schindler

teach the method of claim 39, Glenn further teaches wherein selecting the at least one

visual indicator initiates at least one user interface configured to enable the recipient to

send an instant message communication to an identity associated with the visual

indicator. (See Glenn, paragraph 0046)

As per claim 42, which is dependent on claim 18, Glenn, Kudoh and Schindler

teach the method of claim 18, Glenn further teaches wherein the instruction for indicating

the online state comprise instruction for indicating the online state of the sender of the e-

mail message. (See Glenn, paragraph 0046)

As per claims 43-45 are rejected with the same rationale as clam 34. (See

rejection above)

As per claim 46, which is dependent on claim 18, it is of the same scope as claim

39. (See rejection above)

As per claim 47, which is dependent on claim 23, it is of the same scope as claim

42. (See rejection above)

As per claims 48-50 are rejected with the same rationale as clam 34. (See

rejection above)

As per claim 51, which is dependent on claim 23, it is of the same scope as claim 8. (See rejection above)

As per claim 52, which is dependent on claim 26, it is of the same scope as claim 42. (See rejection above)

As per claims 53-55 are rejected with the same rationale as clam 34. (See rejection above)

As per claim 56, which is dependent on claim 26, it is of the same scope as claim 8. (See rejection above)

As per claim 57, it is rejected with same rationale as claim 1. (see rejection above)

As per claim 58, which is dependent on claim 57, it is of the same scope as claim 42. (See rejection above)

As per claims 59-61 are rejected with the same rationale as clam 34. (See rejection above)

As per claim 62, which is dependent on claim 57, it is of the same scope as claim 8. (See rejection above)

As per claim 63, which is dependent on claim 57, it is of the same scope as claim 8. (See rejection above)

As per claim 64, which is dependent on claim 63, it is of the same scope as claim 8. (See rejection above), Kudoh further teach the recipient from within a user interface for an email communication system (see Kudoh, column 4, lines 32 – 36)

As per claim 65, which is dependent on claim 63, Glenn, Kudoh and Schindler teach the method of claim 63, Glenn further teaches indicating the online state comprises

displaying the one or more visual indicators to the recipient from within a user interface

for an instant messaging system. (See Glenn, paragraph 0046)

As per claims 66-67 are rejected with the same rationale as clam 34. (See

rejection above)

As per claim 68, which is dependent on claim 63, it is of the same scope as claim

6. (See rejection above)

As per claim 71, which is dependent on claim 63, it is of the same scope as claim

39. (See rejection above)

As per claim 72, which is dependent on claim 71, it is of the same scope as claim

40. (See rejection above)

As per claim 73, which is dependent on claim 71, it is of the same scope as claim

41. (See rejection above)

As per claim 74, Glenn and Kudoh teach the claim of 71, Glenn further teaches

wherein the online state determines a type of user interface that is initiated. (Figure 2,

item 206)

As per claim 75, it is rejected with the same rationale as claim 1. (see rejection

above)

As per claim 76, which is dependent on claim 75, it is of the same scope as claim

19. (See rejection above)

As per claim 77, which is dependent on claim 75, it is of the same scope as claim

20. (See rejection above)

As per claim 78, which is dependent on claim 75, it is of the same scope as claim 21. (See rejection above)

As per claim 79, which is dependent on claim 75, it is of the same scope as claim 22. (See rejection above)

As per claim 80, it is rejected with the same rationale as claim 1. (See rejection above)

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 20020021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 as applied to claim 4 above, further in view of Schindler (US 6,081,830) and further in view of Bezos, U.S. Patent No. 6,525,747.

As per claim 5, which is dependent on claim 4, Glenn, Kudoh and Schindler teach the method of claim 4 (see rejection above). They do not teach the method of claim 4 wherein the e-mail message comprises an invitation to join the communications system. Bezos teaches wherein an e-mail message comprises an invitation to join the communications system (see Bezos, column 7, lines 5 - 31). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Bezos with the method of Glenn, Kudoh and Schindler in order to allow the user to provide other users with access to private discussion information.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 20020021307 in view of Kudoh et al.,

U.S. Patent No. 5,948,058 as applied to claim 9 above, further in view of Schindler (US

6,081,830), and further in view of Bunney, U.S. Patent No. 6,446,112.

As per claim 10, which is dependent on claim 9, Glenn, Kudoh, Schindler teach

the method of claim 9 (see rejection above). They do not teach the method of claim 9

wherein the request comprises at least one e-mail address. Bunney et al. ("Bunney")

teaches wherein a request to check user online state comprises at least one e-mail address

(see Bunney, column 10, lines 1 - 9). It would have been obvious to one of ordinary skill

in the art at. the time of the invention to incorporate the method of Bunney with the

method of Glenn, Kudoh, and Schindler in order to allow a user to link existing email

addresses with internet chat handles.

Claim 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Glenn et al., U.S. Patent Application Publication No. US 20021002l307 in view of

Kudoh et al., U.S. Patent No. 5,948,058 further in view of Schindler (US 6,081,830)

further in view of Alexander et al. (US 6,640,230)

As per claim 69, Glenn, Kudoh, and Schindler teach the method of 63, however

they fail to teach where in at least one of the visual indicator comprises text.

Alexander et al. further teaches where in at least on of the visual indicator

comprises text. (Figure. 11, item 1100)

It would have been obvious to an artisan at the time of the invention to include

Alexander's teaching with method of Glenn, Kudoh and Schindlerin order to give

recipient information regarding how to contact the sender.

As per claim 70, Glenn, Kudoh, Schindler, and Alexander teach the method of

claim 69. Alexander further teach the text comprises one or more of a name or an e-mail

address. (Figure 10, item 1080)

Response to Argument

Applicant's arguments with respect to claims 1-80 have been considered but are

deemed to be moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The

examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-

9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Peng Ke

Kristine Kincaid
KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100